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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,059	04/26/2001	Rabindranath Dutta	AUS920010411US1	8459

7590

03/29/2006

International Business Machines Corporation  
Intellectual Property Law Department  
Internal Zip 4054  
11400 Burnet Road  
Austin, TX 78758

EXAMINER
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WONG, LESLIE

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/843,059

Applicant(s)

DUTTA ET AL.

Examiner

Leslie Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-10, 13-16 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13-16 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/13/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

2. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

Claims 1, 9, 15, 21, 23, 24 recite "displaying the chronological list...**for enabling**...", the language "for enabling" appears to be a statement of intended use. Thus the "display step... for enabling" does not actually render the stored multimedia

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objects. As such, the claim is not a practical application and therefore, is rejected for containing non-statutory subject matter.

Claims 10 and 24, recite "...computer usable medium...". Applicant's specification, page 21, lines 5-11, discloses that

"[E]xamples of computer usable mediums include, but are not limited to: nonvolatile, hard-coded type mediums such as read only memories (ROMs) or erasable, electrically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-ROMS, and transmission type mediums such as digital and analog communication links, or any **signal bearing** medium."

The fact that the computer usable medium includes the signal renders the claims not statutory because it's not tangle.

In order to overcome the above 101 rejection, it is suggested that the computer- usable medium claims be amended to recite "A computer usable **storage** medium" to ascertain that the claims fall within the statutory classes of § 101.

Claims 2-4, 7-8, 13-14, 16, 19-20, and 22 are rejected for fully incorporating the deficiencies of their respective base claims by dependency.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four categories of invention.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "tangible".

Applicant is suggested to remove the term "tangible" in the claims because there is no support for such term in the specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-10, 13-16, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Cannon et al.** ("Cannon") (US 6754715 B1).

Regarding claims 1, 7, 10, 14, and 15, **Cannon** teaches a method, computer program product, and system for displaying, at a client. Transient messages received over a network, the method comprising:

- a). storing in a chronological list, independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the client (col. 16, lines 44-54; claim 16); and
- b). displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object (col. 6, lines 6-24; col. 15, lines 21-35, and claim 16).

Regarding claims 2 and 16, **Cannon** further teaches wherein each one of the plurality of different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object (col. 16, lines 41-44).

Regarding claim 3, **Cannon** further teaches storing further comprises storing at least one of the multimedia objects at the client (col. 7, lines 22-25).

Regarding claims 4, 8, 13, and 19, **Cannon** further teaches wherein the step of storing further comprises storing at least one of the multimedia objects at a server which is in communication over the network with the client (col. 7, lines 1-7; Fig. 1A, and claim 16).

Regarding claim 9, **Cannon** teaches a method for displaying, at a client, transient messages received over a network, the method comprising:

a). storing, at a server which is communicatively connected over the network with the client in a chronological list independently of a user action, a plurality of different multimedia objects each containing at least one transient message when each multimedia object is initially rendered at the clients (col. 16, lines 44-54; claim 16);

b). displaying the chronological list with control buttons for enabling a subsequent rendering of the stored multimedia objects in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object (col. 6, lines 6-24; col. 15, lines 21-35, and claim 16); and

c). sending a next sequential given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in an area of a document allocated to the multimedia object in response to a selection of a replay button sent from the server displayed at the client in an area of a document allocated to the multimedia object (col. 16, lines 44-54).

Regarding claim 20, **Cannon** further teaches means for sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection a replay

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button sent from server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object (col. 16, lines 44-54).

Regarding claims 21- 24, **Cannon** teaches a method and computer program product for redisplaying, at a client, at least one transient message displayed in a browser, the method comprising:

- a). identifying a region associated with the at least one transient message (col. 4, lines 50-64);
- b). clipping the region associated with the at least one transient message (col. 4, lines 50-64);
- c). storing in a chronological list, independently of a user action, each transient message when each transient message is initially rendered by the browser (col. 16, lines 44-54; claim 16); and
- d). displaying the chronological list with control buttons for enabling a subsequent rendering the transient messages in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given transient message (col. 6, lines 6-24; col. 15, lines 21-35, claims 16 and 26).

***Response to Argument***



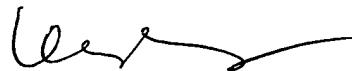
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5. Applicant's arguments with respect to claims 1-4, 7-10, 13-16, and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong  
Primary Patent Examiner  
Art Unit 2164

LW  
March 24, 2006